

REMARKS

Claims 27 through 52 are pending in this Application. Claims 38 through 52 have been amended. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, FIG. 3, ¶¶ [0005], [0006], [0033] through [0038], [0065] through [0068] of the originally filed specification. Applicants submit that the present Amendment does not generate any new issue or new matter. In particular, limitations from claims 27 through 37 have been included in claims 38 through 52. Therefore, the present Amendment does not generate any new matter issue.

Claims 27 through 52 are rejected under 35 U.S.C. 102(e) as being anticipated by *McIsaac et al.* (US 2008/0195551).

In stating the rejection, the Examiner asserted that *McIsaac et al.* disclose all elements of the claimed inventions. Applicants respectfully traverse this rejection.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, as those elements are set forth in the claims, such that the claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1308, (Fed. Cir. 2008); *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002); *Candt Tech Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344 (Fed. Cir. 2001). Moreover, when imposing a rejection under 35 U.S.C. §102 for lack of novelty, the Examiner is required to specifically identify where in the applied reference disclosed each and every feature of the claimed invention,

particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are fundamental differences between the claimed transaction mechanism updating scheme and *McIsaac et al.* that scotch the factual determination that *McIsaac et al.* disclose, or even remotely suggest, any of the claimed transaction mechanism updating schemes.

Specifically, independent claims 27, 38 and 48 recite, “wirelessly receiving, by a mobile station from **a management service provider**, a message comprising control information for updating the mobile station for wirelessly conducting a transaction by the mobile station directly with **a merchant**, wherein **the merchant is independent of the management service provider**,” and “updating the mobile station in response to receipt of the message, at the mobile station from **the management service provider**, and in accordance with the control information of the message, wherein, after updating, the mobile station is configured to conduct the transaction by the mobile station **directly with the merchant** and without the management service provider.” None of these features are disclosed or suggested by *McIsaac et al.*

The claimed transaction mechanism updating scheme relates to at least a situation where the user wishes to start using a new transaction mechanism to purchase goods or services from a new merchant or to update an existing transaction mechanism of an old merchant that has been changed (§ [0065] of the corresponding US Publication No. 2002/0193102). A transaction mechanism is required to accomplish electronic transactions between two entities, and it can be defined to comprise features such as the communication media between the parties, predefined transaction protocols and parameters, predefined content transfer and presentation formats, security mechanisms and other functions that may also associate with an electronic transaction

between the parties (§ [0005]). A dynamic template 24 contains information such as rules, references, parameters, etc. may be used in updating the transaction mechanisms in a use case of an electronic wallet (§§ [0033]; [0036]).

According to the transaction mechanism updating scheme of the claimed inventions, a message comprising control information for updating the mobile station for wirelessly conducting a transaction by the mobile station directly with **a merchant** is received by a mobile station from **a management service provider that is independent of the merchant**. In contradistinction to the claimed inventions, the alleged **management service provider** in *McIsaac et al.* specifically includes a **merchant** server 120 (page 2, last paragraph of the outstanding Office Action) that is clearly affiliated with the merchant. Therefore, the alleged management service provider in *McIsaac et al.* **includes the merchant**, rather than “being independent of the merchant” as recited in the claimed transaction mechanism updating scheme.

Assuming, arguendo, (and rejections under 35 U.S.C. §102 must be based on facts not assumptions, *Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991)) the alleged management service provider in *McIsaac et al.* includes a security server, a buyer’s payment information server, etc., while excluding the merchant server 120, *McIsaac et al.* still fail to disclose or suggest the claimed transaction mechanism updating scheme in any of the described embodiments.

For example, in the embodiment of *McIsaac et al.* (FIG. 4, §§ [0076] through [0080]) relied upon by the Examiner, after a security server 130 updates a delivery document E1 and a payment document E2 and a payment processor server 140 carries out the payment (i.e., parts of the alleged management service provider), the transaction is finished without the involvement of

the merchant server 120 (§ [0070]) such that the transaction is completed without disclosing buyer's private information to the merchant server 120 (§ [0080]).

In particular, the merchant server 120 can store only order information (§ [0078]) but not a digest array of buyer private information that is collected and maintained by the security server 130 (§ [0077]), since the buyer private information encrypted to be decrypted by the payment server 140 etc. which have a key (§§ [0078], [0079]) but not the merchant server 120. The merchant server 120 can not conduct future transactions without the security server 130. Any future transactions will involve the security server 130 (i.e., a part of the alleged management service provider), rather than “conducting the transaction by the mobile station directly with the merchant and **without** the management service provider” as recited in the claimed transaction mechanism updating scheme.

It is therefore apparent that *McIsaac et al.* operate in a manner opposite to the claimed inventions, thereby clearly teaching away from the claimed inventions. Simply put, *McIsaac et al.* neither disclose nor suggest “updating the mobile station in response to receipt of the message, at the mobile station from **the management service provider**, and in accordance with the control information of the message, wherein, after updating, the mobile station is configured to conduct the transaction by the mobile station **directly with the merchant** and without the management service provider” as recited in the claimed transaction mechanism updating schemes. .

The above-argued fundamental and functionally significant differences between the claimed transaction mechanism updating schemes and *McIsaac et al.* undermine the factual determination that *McIsaac et al.* *identically* disclose the claimed transaction mechanism updating schemes within the meaning of 35 U.S.C. §102(a). *Minnesota Mining &*

Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 27 through 52 under 35 U.S.C. §102(e) for lack of novelty based on *McIsaac et al.* is not factually viable, and hence, solicit withdrawal thereof.

Based upon the foregoing, it is apparent that the imposed objection and rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

September 14, 2009
Date

/Arthur J. Steiner/
Arthur J. Steiner
Attorney for Applicant(s)
Reg. No. 26106

Chih-Hsin Teng
Attorney for Applicant(s)
Reg. No. 63168

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9951
Fax (703) 519-9958